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HEWLETT PACKARD COMPANY			DAHBOUR, HENRY	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/826,008	BRAKE ET AL.
	<b>Examiner</b> HENRY DAHBOUR	Art Unit 2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 19 May 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 2-50 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 2-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 16 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 2, 18, 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (U.S.20050094216).

Regarding claim 2, Wu discloses a scanner comprising a substantially transparent platen on a first side of the scanner (see "transparent platen 34" in paragraph [0017], also see 34 in Figure 2), a substantially transparent window on a second side of the scanner opposite the first side (see "transparent platen 32" in paragraph [0017], also see 32 in Fig.2), a touchscreen affixed proximate to the substantially transparent window wherein touch location information is generated in response to at least one touch of the touchscreen and wherein the touch location information is used to select an area to scan (see "the scanning area can easily be set...as shown in Fig. 3" in paragraph [0021], and also see "a sensitive screen can be used for the back transparent platen 34 and two points at diagonal position can define the scanning area" in paragraph [0021], also see "touchscreen" in paragraph [0021]).

Regarding claim 18, Wu discloses a system comprising a scanner comprising a substantially transparent platen on a first side of the scanner (see "transparent platen 34"

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in paragraph [0017], also see 34 in Figure 2), a substantially transparent window on a second side of the scanner opposite the first side (see "transparent platen 32" in paragraph [0017], also see 32 in Figure 2), a touchscreen affixed proximate to the substantially transparent window wherein touch location information is generated in response to at least one touch of the touchscreen and wherein the touch location information is used by the system to select an area to scan (see "the scanning area can easily be set...as shown in Fig. 3" in paragraph [0021], and also see "a sensitive screen can be used for the back transparent platen 34 and two points at diagonal position can define the scanning area" in paragraph [0021], also see "touchscreen" in paragraph [0021]) near the platen (see where the scanner meets the book in Figure 2), and a computer wherein the computer and the scanner are in communication (see "scanner is used...with a computer through a...interface" in paragraph [0016]).

Regarding claim 35, see rejection of claim 2.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-9, 19-26, 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S.20050094216).

Regarding claim 3, Wu does not disclose a figure traced on the touchscreen by a user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on what the user wants to scan.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 3.

Regarding claim 4, Wu does not disclose that the area to scan is rectangular.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on what the user wants to scan.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 4.

Regarding claims 5-7, Wu does not disclose that touches occurring during a predetermined interval of ten seconds, immediately preceding initiation of a scan, are considered in the selection of the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on what the user wants to input the area to scan.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 5-7.

Regarding claims 8, Wu does not disclose that touches occurring after a reset operation, are considered in the selection of the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on when the user wants to input the area to scan.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 8.

Regarding claim 9, Wu does not disclose scanner control logic for interpreting the touch location information and selecting the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that "the scanning operations can be performed...the related software for scanning can be stored and run in a CPU and related memory provided on the portable flatbed scanner" (see paragraph [0023] ).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 9.

Regarding claims 19-20, Wu does not disclose that the communication is cable or wireless.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because whether the communication is cable or wireless, it would still achieve the same purpose of establishing a connection between the scanner and computer.

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 19-20.

Regarding claim 21, Wu does not disclose that the touch location information is sent to the computer which sends to the scanner configuration information derived from the touch location information, the configuration information indicating the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that it is possible for scanning parameters to be set through a computer (see "scanning parameters ...can be set up through a computer" in paragraph [0018]).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 21.

Regarding claim 22, see rejection of claim 3.

Regarding claim 23, see rejection of claim 4.

Regarding claim 24, see rejection of claim 5.

Regarding claim 25, see rejection of claim 6.

Regarding claim 26, see rejection of claim 7.

Regarding claim 36, see rejection of claims 3 & 4.

Regarding claim 37, see rejection of claims 5 & 6.

Regarding claim 38, see rejection of claim 7.

Regarding claim 39, see rejection of claim 8.

Regarding claim 40, Wu does not disclose being performed entirely in the scanner.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that it is possible to have "related software for scanning...stored and run in a CPU and related memory provided on the portable flatbed scanner" (see paragraph [0023] ).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 40.

Regarding claim 41, Wu does not disclose being partly performed in the scanner and partly performed in a computer that is in communication with the scanner.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because Wu teaches that it is possible to have "a flatbed scanner is used in association with a computer through a computer interface...The software in the computer can set up the scanning parameters and control the scanning operation" (see paragraph [0016]).

Wu is analogous art because it is from the art of imaging devices.

Therefore, it would have been obvious to combine this feature with Wu, to obtain the invention specified in claim(s) 41.

5. Claims 10-12, 27-29, 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S.20050094216) in view of the admitted prior art.

Regarding claim 10, Wu does not disclose a preview scan that results in a preview digital image, and analyzing the preview digital image using automated region detection, and selecting as the area to scan an automatically detected region that encompasses a location.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features in the device of Wu.

The suggestion / motivation for doing so would have been because the admitted prior art teaches that these features are nothing new in the art (see "typical desktop scanner...performs a preview scan...The preview scan data...has been analyzed ...perform automated region classification and selection based on analysis of the results

of a preview scan, so that a user need only designate...which of the suggested regions displayed on the computer screen represents the area to be captured" in paragraphs [002]-[003] of applicant's specification).

Wu and the admitted prior art are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with the admitted prior art to obtain the invention specified in claim(s) 10.

Regarding claims 11-12, Wu does not disclose that the preview scan occurs before or after the touch of the touchscreen.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have this feature, in the device of Wu.

The suggestion/motivation for doing so would have been because it depends on when the user wants to perform a preview scan.

Wu and the admitted prior art are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with the admitted prior art to obtain the invention specified in claim(s) 11-12.

Regarding claim 27, Wu also does not disclose transmitting the preview digital image to the computer, analyzing in the computer, software, and sending configuration information from the computer to the scanner.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features in the device of Wu.

The suggestion / motivation for doing so would have been because the admitted prior art teaches that these features are nothing new in the art (see "typical desktop scanner...performs a preview scan...The preview scan may be initiated by selecting a function in software operating on the computer...perform automated region classification and selection based on analysis of the results of a preview scan, so that a user need only designate...which of the suggested regions displayed on the computer screen represents the area to be captured" in paragraphs [002]-[003] of applicant's specification, also see "interact...the computer and the scanner" in paragraph [004]).

Wu and the admitted prior art are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with the admitted prior art to obtain the invention specified in claim(s) 27.

Regarding claim 28, see rejection of claim 11.

Regarding claim 29, see rejection of claim 12.

Regarding claim 42, see rejection of claim 10.

Regarding claim 43, see rejection of claim 12.

Regarding claim 44, see rejection of claim 11.

Regarding claim 45, see rejection of claim 27.

6. Claims 13-17, 30-34, 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S.20050094216) in view of Chiba et al (U.S.7292378).

Regarding claim 13, Wu does not disclose a liquid crystal panel interposed between the touchscreen and the substantially transparent window, wherein the liquid crystal panel is used to provide user feedback about the selected area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Chiba teaches a liquid crystal panel and a touchscreen being used together on a scanner, for user input related purposes (see "image reader 1300 according to...FIG.31" in lines 4-5 in col.61, also see "a touch screen 1314 is adhered to the LCD 1313 and is utilized to input commands required for various types of operations...For inputting a command using the touch screen 1314, a pen 1322 shown in FIG.34 may be used...The pen 1322 can be held at the holding section 1322a, a user presses the touch screen 1314 with the tip section 1322b while visually checking an operating input screen displayed on the LCD 1313 shown in FIG.31" in lines 50-65 in column 64).

Wu and Chiba are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with Chiba to obtain the invention specified in claim(s) 13.

Regarding claim 14, Wu does not disclose that user feedback is provided by switching at least one liquid crystal element in the liquid crystal panel to a light-blocking state in response to at least one touch of the touchscreen.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Chiba teaches a liquid crystal panel and a touchscreen being used together on a scanner, for user input related purposes (see "image reader 1300 according to...FIG.31" in lines 4-5 in col.61, also see "a touch screen 1314 is adhered to the LCD 1313 and is utilized to input commands required for various types of operations...For inputting a command using the touch screen 1314, a pen 1322 shown in FIG.34 may be used...The pen 1322 can be held at the holding section 1322a, a user presses the touch screen 1314 with the tip section 1322b while visually checking an operating input screen displayed on the LCD 1313 shown in FIG. 31" in lines 50-65 in column 64).

Wu and Chiba are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with Chiba to obtain the invention specified in claim(s) 14.

Regarding claim 15, Wu does not disclose that the liquid crystal elements nearest to locations where the touchscreen is touched are switched to the light-blocking state.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Chiba teaches a liquid crystal panel and a touchscreen being used together on a scanner, for user input related purposes (see "image reader 1300 according to...FIG.31" in lines 4-5 in col.61, also

see "a touch screen 1314 is adhered to the LCD 1313 and is utilized to input commands required for various types of operations...For inputting a command using the touch screen 1314, a pen 1322 shown in FIG.34 may be used...The pen 1322 can be held at the holding section 1322a, a user presses the touch screen 1314 with the tip section 1322b while visually checking an operating input screen displayed on the LCD 1313 shown in FIG.31" in lines 50-65 in column 64).

Wu and Chiba are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with Chiba to obtain the invention specified in claim(s) 15.

Regarding claim 16-17, Wu does not disclose that the liquid crystal elements switched to the light-blocking state outline a rectangular perimeter of the area to scan.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have these features, in the device of Wu.

The suggestion/motivation for doing so would have been because Chiba teaches a liquid crystal panel and a touchscreen being used together on a scanner, for user input related purposes (see "image reader 1300 according to...FIG.31" in lines 4-5 in col.61, also see "a touch screen 1314 is adhered to the LCD 1313 and is utilized to input commands required for various types of operations...For inputting a command using the touch screen 1314, a pen 1322 shown in FIG.34 may be used...The pen 1322 can be held at the holding section 1322a, a user presses the touch screen 1314 with the tip section 1322b while

visually checking an operating input screen displayed on the LCD 1313 shown in FIG. 31" in lines 50-65 in column 64).

Wu and Chiba are analogous art because they are from the same field of endeavor, that is the art of imaging devices.

Therefore, it would have been obvious to combine Wu with Chiba to obtain the invention specified in claim(s) 16-17.

Regarding claim 30, see rejection of claim 13.

Regarding claim 31, see rejection of claim 14.

Regarding claim 32, see rejection of claim 15.

Regarding claim 33, see rejection of claim 16.

Regarding claim 34, see rejection of claim 17.

Regarding claim 46, see rejection of claim 13.

Regarding claim 47, see rejection of claim 14.

Regarding claim 48, see rejection of claim 15.

Regarding claim 49, see rejection of claim 16.

Regarding claim 50, see rejection of claim 17.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY DAHBOUR whose telephone number is (571)272-4295. The examiner can normally be reached on 9:00AM-5:30PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HD

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625